

Patent 6,342,578 is described on page 2 of the present application and is assigned to applicant. This patent disclosed the use of anhydrides in a polyester composition to reduce stress cracking in container bottles. On page 2 of the Office Action, the Examiner has set forth arguments under the heading "Response to Arguments". Clearly applicant does not fully understand the Examiner's response to Applicant's previous arguments. In particular, the second sentence is difficult to understand and may have omitted words or terms but nevertheless, it appears the Examiner is stating that substituted cyclic "anhydrides are not satisfactorily stated in the claims". In viewing Claim 1, for example, it clearly calls for a resin comprising polyethylene terephthalate, a dicarboxylic acid and "substituted cyclic anhydride". Claim 2 sets forth specific substituted cyclic anhydrides. Claims 3-6 are further modifications of Claim 2. Accordingly, the undersigned does not understand why the Examiner states that substituted cyclic anhydrides are not satisfactorily stated in the claims. To the undersigned, Claims 1-6 are related directly to substituted cyclic anhydrides, and were clearly stated. Should the Examiner maintain this "rejection", which is not set forth in normal rejection wording, the applicant kindly asks the Examiner to state why the "substituted cyclic anhydrides are not satisfactorily stated in the claims".

In the third sentence in the Examiner's response is the Examiner suggesting the applicant must incorporate THE language set forth on pages 9-13 of the specification into the claims? Why wouldn't Claims 2-6 be sufficient?

The Examiner then states that, "The fact, that the reference states cyclic anhydride does not automatically exclude those which are substituted". Applicant respectfully disagrees for the reasons set forth below.

U. S. Patent 5,244,917 column 2, lines 44-49, states "the term 'substituted' as used herein, means that one or more hydrogen on the designated item is replaced with selection from the indicated group, provided that the designated atoms' normal valency is not exceeded, and that the substitution results in a stable compound". It is clear to one skilled in the art what is meant by "substituted" as a chemical word used frequently in the

art. Based on this reference, it is not believed that the Examiner is unclear about what is meant by "substituted" as that word applies to anhydrides. Therefore, it is felt that substituted cyclic anhydrides is satisfactorily stated in the claims. The formulations set forth in the specification on pages 9-13 are not needed to clarify what is meant by substituted cyclic anhydrides.

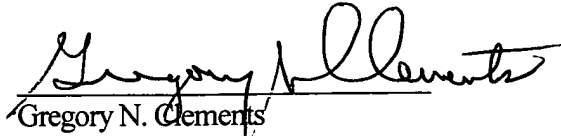
Furthermore, U. S. Patent 5,344,937 discusses the term "substituted or unsubstituted phenyl". This reference equates "unsubstituted phenyl" with phenyl. Accordingly, one could make the analogy in the present application that substituted cyclic anhydride means precisely that, while cyclic anhydrides may also be described as unsubstituted anhydride. Therefore, the Examiner's statement "the fact, that the reference states cyclic anhydrides does not automatically exclude those which are substituted" is in error. In view of U. S. Patent '937, it is clear that there is a distinction between substituted and unsubstituted compounds. It is also understood by those skilled in the art that unsubstituted compounds equate to, as this applies to the present invention, unsubstituted anhydrides, which are those claimed in the reference that the Examiner applies against all the claims under 35 U.S.C. §102.

On page 3 of the Office Action, the Examiner, after stating what the reference discloses, states in the paragraph bridging pages 3 and 4, that the reference discloses a polymer resin prepared from the same components as claimed by applicants. This is incorrect based upon the references '917 and '937. It is clear to those skilled in the art what is meant by "substituted" and in view of '917 and '937, it is clear that unsubstituted chemical compositions mean, as that applies to the present invention, anhydrides only and not substituted anhydrides. Thus each of the limitations in the present application cannot clearly be found in the reference employed by the Examiner.

In view of these arguments, and in view of the references provided to the Examiner only for the purpose of clarifying substituted vs. unsubstituted chemical

compounds, it is submitted that the Examiner's rejection is improper and that the current claims, in view of the rejection, is moot and now in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gregory N. Clements", is written over a horizontal line.

Gregory N. Clements  
Attorney for Applicant(s)  
Registration No. 30,713  
DOUGHERTY | CLEMENTS  
1901 Roxborough Road, Suite 300  
Charlotte, North Carolina 28211  
Telephone: 704/366-6642  
Facsimile: 704/366-9744

GNC/nb

Attorney Docket 2003/04